

REMARKS

The present amendment is in response to the Office Action dated July 13, 2007, where the Examiner has rejected claims 1-24. In the present amendment, claims 1, 7, 12, 18, and 21-24 have been amended. Accordingly, claims 1-24 are pending in the present application with claims 1, 7, 12, and 18 being the independent claims. Reconsideration and allowance of pending claims 1-24 in view of the amendments and the following remarks are respectfully requested.

A. Objection To The Specification

In the Office Action, the Specification is objected to. In response, applicant amended the specification as indicated in the "Amendments to the Specification" section. The objection is now moot.

B. Rejection of Claims 1-24 Under 35 USC § 103

Claims 1, 2, 4-6, 18, and 21-24 stand rejected under section 103(a) as being unpatentable over GraFX Saver Pro,

<http://web.archive.org/web/20020823011437/www.cdhnow.com/gs.html> (CDH

Productions) in view of How To Write A 32-Bit Screen Saver

<http://www.wischik.com/scr/howtoscr.html> (Wischik). Claim 3 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of U.S. Patent No. 6,493,743 (Suzuki). Claims 7, 9, 12, 13, 15, and 16 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of U.S. Patent No. 6,421,235 (Ditzik). Claim 8 stands rejected under section 103(a) as being unpatentable over CDH Productions in

view of Wischik and Ditzik and in further view of U.S. Patent Application No. 2002/0055992 (King). Claim 10 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of U.S. Patent Application No. 2003/0169306 (Makipaa). Claims 11 and 14 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of U.S. Patent No. 6,810,115 (Fukuda). Claim 17 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik in further view of King. Claims 19 and 20 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of King. The rejections are traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

In the Office Action, no motivation has been supplied for combining the references. With respect to the independent claims 1 and 18, the foregoing rejections

all rely on CDH productions and Wischik. With respect to the independent claims 7 and 12, the foregoing rejections rely on the same references in addition to Ditzik for the disclosure of a wireless device.

The present independent claims 1, 7, 12, and 18 are directed to not only arranging and playing a media production on a device, but also to playing different media productions in response to different trigger events. For example, a first media production might play when the battery is low, while another media production might play when the device receives a call. (See, page 10 of the present Application). To that end, claim 1 allows the user, for example, to arrange media objects in first and second ordered sequences and to select one of the ordered sequences from a list in response to different trigger events.

CDH productions is directed to developing screen savers. Wischik is directed to playing a screen saver in response to a trigger event. Even if CDH productions could be combined with Wischik, however, it would still not motivate someone having skill in the art to create an association such as a "list" to associate the media productions with the different trigger events, as is presently claimed. Furthermore, CDH Productions in combination with Wischik would not create a motivation for a user to create multiple media productions and associate them with different trigger events in the list and then select one of the media productions from the list in response to one of the plurality of trigger events.

For example, Wischik describes the process for creating a screen saver for a Windows environment. Even if the trigger events include inactivity or moving the mouse to one of four corners on the screen, the same "media production" or screen saver

occurs. In the windows environment, the screen saver is set in the control panel, then each time the trigger event happens, the screen saver that is set in the control panel is played.¹

Even if one combined CDH Productions with Wischik, there still is no motivation to create an association list between trigger events and media productions because in Wischik, the same screen saver is always associated with all of the potential trigger events. For at least that reason, there is no suggestion or motivation to combine CDH Productions with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success, which is the second requirement of the obviousness analysis. For example, even if CDH Productions could be combined with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda, it would still not result in an association list between trigger events and media productions as is presently claimed.

For example, the trigger events taught by Wischik are in a 32-bit Windows environment where all the trigger events cause the same screen saver to be invoked. (i.e., the screen saver set in the control panel). In such a case no association list is needed because the default screen saver would always be associated with each trigger event so such an association list would waste memory and serve no function. In fact, if

¹ See, for example, “When and Where to Save Configuration” section of Wischik where it states: “whenever a user brings up the configuration dialog for a particular saver and clicks OK, then the changes to the configuration for that particular saver are written to the registry immediately. But the current choice of screen saver appears in the control panel itself and changes to it do not actually take effect, or get written to the registry, until the user clicks OK or Apply on the Desktop control panel itself! . . . So someone might select a saver and spend ages configuring it but then fail to close the control panel: and when they use hot corners to see the effect immediately Windows will not launch the saver they had so painstakingly configured, but instead will launch the previous saver!

such a table listed the trigger events in one column and the screen saver in another column, the screen saver column would always be the same because the default screen saver is always invoked. This would cause the processor to process data unnecessarily and slow down the system with wasted instructions. Therefore, the proposed combination of CDH Productions with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda does not create a reasonable expectation of success.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. First, with respect to independent claim 1, none of the references teach (i) "receiving second configuration instructions from a user, the second configuration instructions comprising selecting and ordering the plurality of media objects, and specifying a transition between the plurality of media objects," (ii) "arranging the plurality of media objects into a second ordered sequence responsive to the configuration instructions," or (iii) "associating the second ordered sequence of media objects with a second trigger event."

Second, with respect to independent claim 1, none of the references teach (i) "accessing a list identifying a plurality of associations between trigger events and ordered sequences of media objects, including at least an entry corresponding to the association between the first trigger event and the first ordered sequence," or (ii) "choosing the entry in the list." [emphasis added]. The remaining independent claims 1, 7, 12, and 18 include similar limitations although the actual wording varies. The following argument applies to each of the remaining independent claims as well as claim 1.

CDH Productions does not teach a trigger event at all. Wischik teaches only a Windows screen saver where each trigger event is always associated with a default screen saver set in the control panel. As such, the trigger event is always directed to the same screen saver. In such a scenario, there is no purpose, nor is there a teaching or suggestion, for a list associating the screen savers with the trigger events and choosing one of the entries in the list, as is presently claimed. Moreover, as is stated in claim 1, since Wischik teaches a Windows screen saver that is invoked every time different trigger events occur, there is no teaching to create a “second” ordering of media objects that are invoked in response to a “second” trigger event, since Wischik treats all trigger events the same.

Even if Suzuki can publish the screen saver to a remote device, it still does not perform the step of “accessing” or “choosing” as defined by the claims because even if the screen saver is published elsewhere, it is still always invoked in response to any and all trigger events as in Wischik.

Even if Ditzik uses a wireless device, it still does not perform the steps of “accessing” or “choosing” as defined by the claims. Whether the screen saver is on a wireless device or a home PC, Ditzik and in particular Ditzik combined with Wischik performs a 32-bit Windows screen saver on a mobile device. In such a scenario, the default screen saver is always played in response to any and all trigger events, so no association list is used.

Even if King uses a GPS location, it merely describes the nature of one potential trigger event. Even if GPS is used as a trigger event, King when combined with the 32-bit Windows screen saver in Wischik still does not perform the step of “accessing” or

"choosing" as defined by the claims, since even if GPS is added as a trigger event the same screen saver (as taught by Wischik) plays regardless of how trigger events are defined.

Even if Makipaa uses a call processor, it still does not perform the step of "accessing" or "choosing" as defined by the claims. For example, claim 10 states that an embedded processor presents the media objects responses to a trigger event generated by the call processor. Even if the call processor in Makipaa performed such a step, the media objects responses will still always be the same screen saver, since Makipaa is combined with Wischik. Wischik defines a 32-bit Windows screen saver. As such, all responses to the call processor would be for the same screen saver, so no association list would be used.

Even if Fukuda uses caller identification information, it still does not perform the step of "accessing" or "choosing" as defined by the claims. Fukuda plays ring tones depending on a particular caller and such ring tones are not media presentations or screen savers as is presently claimed.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and

therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

D. Conclusion

For all the foregoing reasons, an early allowance of claims 1-24 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a).

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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